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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/057,107

01/25/2002

Nico N. Raczek

01/018 NUT

2752

7590

10/06/2004

ProPat, L.L.C.

2912 Crosby Road

Charlotte, NC 28211-2815

EXAMINER

WARE, DEBORAH K

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/057,107	Applicant(s) RACZEK, NICO N.	
	Examiner Deborah K. Ware	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 7/22/04
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                   |                                                                                         |
|-----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

Claims 1-6 and 8-10 are presented for examination on the merits.

#### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on July 22, 2004, is acknowledged. Non-elected claims have been canceled.

#### ***Information Disclosure Statement***

The information disclosure statements (IDSs) submitted on January 25, 2002, May 15, 2002 and June 13, 2002 have been received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Foreign Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6 and 8-10 are rendered vague and indefinite for the recitation of "probiotic activity (=probiotic)" wherein the term is unclear as to what is intended to be conveyed. It is unclear whether the microorganism is to be a probiotic as recognized in

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the art or merely have activity like a probiotic. The use of "(=probiotic)" is especially confusing in the claim and it is suggested to delete this phrase and either refer to a microorganism probiotic or a microorganism having probiotic activity.

Claim 3 also lacks antecedent basis for "the feed produced from the product" at lines 2-3.

Claim 4 also fails to set forth proper Markush language and the metes and bounds of the claim are unclear since it is uncertain what additional probiotic may be selected.

Claim 5 is further rendered vague and indefinite for the recitation of "enzyme product" since it is uncertain what product is intended. The metes and bounds of the claim can not be determined.

Claim 6 also fails to set forth proper Markush language and the metes and bounds of the claim are unclear since it is uncertain what additional enzyme may be selected.

Claim 9 is rendered vague and indefinite for "An addition" because it is uncertain what such "addition" is intended. Is it the product of claim 1 or something added to it or what? The metes and bounds of the claim can not be determined.

Claim 10 is further rendered vague and indefinite for the recitation of ">0.0 to 2.0%" and for "by weight (based on the feedstuff)". The range is unclear as to what lower limit value is greater than 0.0 per se? The lower limit is not certain and renders the claim indefinite. Is there not some specified value for which to indicate the lower limit of the range rather than specifying a range within a range. Perhaps 0.0 to 2.0%

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would be a better way to phrase the range if that is what is intended by the recited range. Further, the phrase "by weight (based on the feedstuff)" does not clearly define by weight of what, is it by weight of product or by weight of feed? The metes and bounds of the claim can not be determined.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,780,447, cited on enclosed PTO-892 Form. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant product is obvious over the claims of the patent and the only difference being in scope.

Claims are drawn to a product which comprises sorbic acid and a microorganism.

Patent claims 1-13 disclose a product comprising sorbic acid and bacteriocin or a bacteriocin producing microorganism.

It would have been obvious to one of skill in the art at the time the claimed invention was made to select for the microorganism of the patent claims for combining with sorbic acid to form the product of the instant claimed. The patent claims clearly teach use of the product in a feed stuff. Therefore, the claims are prima facie obvious over the patent claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-4, 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaesler et al in view of Farmer, both cited on the enclosed PTO-892 Form.

Claims are discussed above.

Kaesler et al teach a solution comprising sorbic acid and probiotic. The product solution can be added to feedstuffs. Note col. 3, lines 1-6 and 59 and col. 4, lines 62-64. Enzymes can be added too.

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Farmer teaches a probiotic microorganism such as bacteria selected from *Bacillus subtilis*, note col. 13, lines 29-30. The microorganism probiotic can be selected and used in a composition such as feed, note col. 24, lines 45-65 and further enzymes may be added such as amylase, note col. 24, lines 15-20. Also the composition is typically formulated in an amount of 0.5 to 10% by weight, note col. 35, lines 1-5.

The claims differ from Kaesler in that microorganism as the probiotic as well as specific microorganism probiotic and specific enzymes are not disclosed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the teaches of Kaesler and Farmer in order to provide for a product comprising sorbic acid and probiotic microorganism selected from *Bacillus subtilis* to add to feed and further to select an amylase to combine therein as well. Both of the cited reference teach these ingredients to be comprised by a product and thus, are well known. One of skill would have been motivated to select for the number of viable cells because the art teaches these amounts and to select for at least 90% by weight of sorbic acid is an obvious modification of Kaesler et al since the acid is comprised of the product taught therein is present in at least that amount. Clearly one of skill would have been motivated to combine these ingredients for addition to feedstuff. The claims are prima facie obvious over the cited prior art.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5 and 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaesler et al.

Claims are discussed above.

Kaesler et al teach a product comprising sorbic acid and (=probiotic). Note col. 3, line 5 and line 59; and also enzymes, note col. 3, line 59. Further it is added to feedstuff, col. 4, lines 63. The dosage in feed may be 0.1%, note col. 5, lines 10 and col. 6 line 31.

The claims are identical to the cited disclosure and are considered to be anticipated by the teachings therein.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

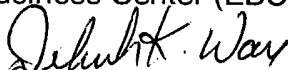
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

  
**DEBORAH K. WARE**  
**PATENT EXAMINER**

Deborah K. Ware  
September 30, 2004